



Docket No: AM100089
Patent

DAC
\$170

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re of Application of: Scott Mason Duncan, et al.
Application No.: 10/820,115 Group Art No.: 1625
Filed: April 7, 2004 Examiner:
For: PROCESS FOR THE SYNTHESIS OF 3-CYANO-6-ALKOXY-7-NITRO-4-QUINOLONES
Confirmation No.: 8422
Customer Number: 25291

Mail Stop Petitions
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

PETITION TO FILE ON BEHALF OF NON-SIGNING INVENTOR(S) IN--
NONPROVISIONAL APPLICATION—DECLARATION
(37 C.F.R. § 1.47)

This is a petition of request to file on behalf of a non-signing inventor in the declaration under 37 C.F.R. § 1.47 as set forth and filed on April 7 2004.

Attached is an explanation of the facts, including the ownership of all claim(s) being claimed in this application, including the ownership of all the claim(s) at the time the last claimed invention was made.

The Commissioner is hereby authorized to charge \$200.00 under 37 C.F.R. § 1.17(g) and any additional fees required by this paper, including the enclosed documents, and during the entire pendency of this application and to credit any excess amounts paid to Deposit Account No. 01-1425. A copy of this letter is enclosed for use by the Deposit Account Branch.

CERTIFICATE OF MAILING 37 CFR §1.10

I hereby certify that this paper and the documents referred to as enclosed therein are being deposited with the United States Postal Service on the date written below in an envelope as "Express Mail Post Office to Addressee" Mailing Label Number ER672187054US addressed to Mail Stop Petitions, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450.

March 28, 2005
Date

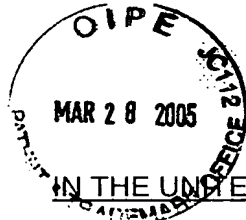
Ann Peterson
Ann Peterson

Respectfully submitted,

03/30/2005 MAHME1 00000048 011425 10820115
01 FC:1463 200.00 DA

Joy S. Goudie
Joy S. Goudie
Attorney for Applicants
Reg. No. 48,146

Wyeth
Patent Law Department
Five Giralda Farms
Madison, NJ 07940
Tel. No. (845) 602-2126



Docket No: AM100089
Patent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re of Application of: Scott Mason Duncan
Miguel Angel Pagan
Middleton Brawner Floyd, Jr.

For: PROCESS FOR THE SYNTHESIS OF 3-CYANO-6-ALKOXY-7-NITRO-4-QUINOLONES

the specification of which:

- (a) ☒ is attached hereto.
- (b) ☐ was filed on _____, as Application Serial No. _____ and was amended on _____
- (c) ☐ was described and claimed in International Application No. _____, filed on _____ and as amended on _____

STATEMENT OF FACTS IN SUPPORT OF FILING ON BEHALF OF NONSIGNING INVENTOR (37 C.F.R. § 1.47)

This statement is made as to the exact facts that are relied upon to establish the diligent effort made to secure the execution of the declaration by the nonsigning inventor for the above-identified patent application before deposit thereof in the Patent and Trademark Office.

- ☒ Because signing on behalf of the nonsigning inventor is by a person or entity showing a sufficient proprietary interest, this statement also recites facts as to why this action was necessary to preserve the rights of the parties or to prevent irreparable damage.

This statement is being made by the available person having first-hand knowledge of the facts recited therein.

IDENTIFICATION OF PERSON MAKING THIS STATEMENT OF FACTS

Joy S. Goudie
Wyeth
Patent Law Department
Five Giralda Farms
Madison, NJ 07940
Tel. No. (845) 602-2126

**EFFORTS DURING CONVENTION YEAR TO PREPARE APPLICATION AND OBTAIN
INVENTOR'S SIGNATURE**

Miguel Pagan executed the Assignment to the Assignee ("Wyeth Holdings Corporation") at the time provisional application 60/461,647, was filed on April 9, 2003. No notice was given to the undersigned attorney at the time Miguel Pagan terminated his employment with the Assignee. The details of the efforts to reach Miguel Pagan ("nonsigning inventor") are set forth below.

LAST KNOWN ADDRESS OF THE NONSIGNING INVENTOR

Miguel Angel Pagan
126 Robbins Road
Mount Hope, NY 10932

DETAILS OF EFFORTS TO REACH NONSIGNING INVENTOR

A Combined Declaration and Power of Attorney and Assignment of Invention was prepared in the names of Scott Mason Duncan, Miguel Angel Pagan and Middleton Brawner Floyed on February 20, 2004. A copy of the Combined Declaration and Power of Attorney and Assignment of Invention was mailed on that date by Wyeth interoffice mail to Middleton Brawner Floyd and by Federal Express to Scott Mason Duncan at 10 Stonecrest Circle, Madison, Wisconsin.

At the time of the mailing undersigned was informed by Ann Peterson that someone else was answering Miguel Pagan's telephone.

The undersigned proceeded to ask the office manager, Janice White, to locate Miguel Pagan.

Janice White of the below signed attorneys office contacted Lisa Struzik in Wyeth Human Resources (B140) regarding Miguel Pagan. She referred Janice White to Linda Vergine in the Wyeth Research Human Resources. Linda Vergine told us that Miguel had transferred from Wyeth in Pearl River, NY, to work in Wyeth Chemical Development in Rouses Point and referred us to Sharon Bouchard, her counterpart in the Wyeth Chazy Human Resources office.

On March 12, 2004 Janice White called Sharon Bouchard. At this time we were officially informed that Miguel Pagan had left the company. There was no forwarding address left since he only worked a few years with the company, not long enough for him to be eligible for a pension.

Janice White spoke with Julie Parrott, who worked as a secretary in the Wyeth Chemical Development Department at Rouses Point, and was told, to the best of her knowledge, that no one had any further contact with Miguel Pagan or knew of his whereabouts.

Ann Peterson called Scott Duncan, a co-inventor on this patent, on March 12, 2004. He told Ann that he didn't have any contact with Miguel Pagan nor did he think anyone else did either. Likewise, co-inventor Middleton Brawner Floyd of Wyeth was contacted and had no information.

A search was run and Miguel Pagan's name was found on a published US application 2003-44356 assigned to Alteon Inc., located at 170 Williams Drive, Ramsey, New Jersey 07446-2907. The undersigned spoke with Arlene MacDonnell of Alteon Inc. (201-934-5000 x22587) and was informed that Miguel Pagan was no longer employed by Alteon and that no forwarding address was provided.

The Combined Declaration and Power of Attorney and Assignment of Invention forms were mailed to the last known address of Miguel Pagan and returned. (Exhibit A)

Consistent with Miguel Pagan's employment with Wyeth an Assignment was executed by Miguel Pagan on March 21, 2003, in provisional application 60/461,647 from which this application claims priority (Exhibit B). Assignment by Miguel Pagan for the subject-application would be consistent with Miguel Pagan's employment with Wyeth at the time of the subject invention.

This statement of Facts in Support of Filing on Behalf of Nonsigning Inventor under 37 CFR § 1.47 is being filed as PROOF OF NEED TO PREVENT IRREPARABLE DAMAGE OR PRESERVE THE RIGHTS OF THE PARTIES.

Date

April 7, 2004

Joy S. Goudie

Joy S. Goudie

EXTREMELY URGENT

Exhibit A

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OR



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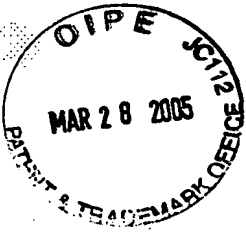
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Mo. 3 Day 7	<input type="checkbox"/> AM <input type="checkbox"/> PM	Signature

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WARRANTY OF SIGNATURE DOMESTIC ONLY

For signature by addressee, business, or individual, use this label. For signature by addressee, business, or individual, use this label. For signature by addressee, business, or individual, use this label.

TO: PLEASE PRINT

PHONE ()

Miguel Angel Pagan

168 Robbins Road

Mount Hope, NY 10932

ATTEMPTED NOT KNOWN

RS

For: ☒ U.S. and/or ☒ Foreign Rights
For: ☒ U.S. Application or ☐ U.S. Patent

Assignment of Invention

In consideration of the payment by ASSIGNEE to ASSIGNOR of good and valuable consideration, the receipt of which is hereby acknowledged,
ASSIGNOR:

-
- (1) Full Name of Inventor: DUNCAN, Scott M.
Residence: 10 Stonecrest Circle, Madison, WI
Citizenship: USA
-
- (2) Full Name of Inventor: PAGAN, Miguel Angel
Residence: 126 Robbins Road, Mount Hope, NY 10932
Citizenship: USA
-
- (3) Full Name of Inventor: FLOYD, Middleton B. Jr.
Residence: 5 Babbling Brook Lane, Suffern, NY 10901
Citizenship: USA
-

hereby sells, assigns and transfers to ASSIGNEE:

Wyeth Holdings Corporation
Five Giralda Farms
Madison, New Jersey 07940

and the successors, assign and legal representatives of the ASSIGNEE the entire right, title and interest for the United States and its territorial possessions and in all foreign countries, including all rights to claim priority in and to the invention entitled:

PROCESS FOR THE SYNTHESIS OF 3-CYANO-6-ALKOXY-7-NITRO-4-QUINOLONES

and invented by ASSIGNOR and the following additional inventors, if any:

and which is found in

[check and complete (a), (b), (c), (d) or (e)]

- (a) ☐ U.S. patent application executed on even date herewith.
(b) ☐ U.S. patent application executed on:
(c) ☒ U.S. provisional application, not yet filed, naming the above inventor(s) for the above-entitled invention
☐ Express mail label no.:
(d) ☐ U.S. application Serial No. filed on:
(e) ☐ U.S. Patent No. issued on:

[also check (f) if foreign application(s) is(are) also being assigned]

- (f) ☒ and any legal equivalent thereof in a foreign country,

including the right to claim priority, including any and all improvements disclosed therein, and in and to all Letters Patent to be obtained for said invention by the above application or any subsequently filed provisional, nonprovisional, continuation, divisional, renewal, or substitute thereof, and as to Letters Patent any reissue or re-examination thereof.

ASSIGNOR hereby covenants that no assignment, sale, agreement or encumbrance has been or will be made or entered into which would conflict with this assignment.

ASSIGNOR authorizes ASSIGNEE to make applications for and to receive Letters patent for said invention in any of said countries in its own name, or in ASSIGNOR's name, at its election.

ASSIGNOR covenants and agrees to execute or procure any further necessary assurance of the title to said invention and any Letters Patent which may issue therefor and to, at any time, upon the request and at the expense of ASSIGNEE deliver any testimony in any interference, litigation or proceeding related thereto and execute all papers that may be necessary or desirable to perfect the title to said invention or any Letters Patent which may be granted therefor in ASSIGNEE, its successors, assigns or other legal representatives, and that to, at any time, upon the request and at the expense of ASSIGNEE execute any continuation, continuation-in-part, divisional, renewal or substitute thereof, and as to Letters Patent and reissue or re-examination thereof, or any other additional applications of Letters Patent for said invention or any part thereof, all of which applications and any Letters Patent issuing thereon are hereby assigned to ASSIGNEE, and will make all rightful oaths or declarations, and do all lawful acts requisite for procuring the same therein, without further compensation, but at the expense of ASSIGNEE, its successors, assigns or other legal representatives.

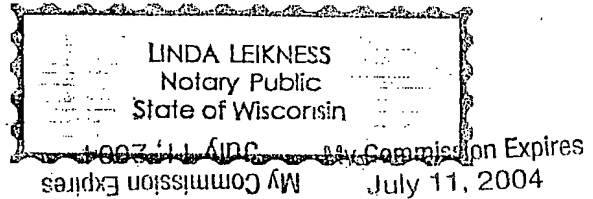
ASSIGNOR authorizes and requests the Commissioner of Patents to issue any and all Letters Patent of the United States for said invention, resulting from any of the aforesaid applications to its ASSIGNEE.

[Signature]
DUNCAN, Scott M. L.S.

3/27/03
Date

~~~~~  
ACKNOWLEDGMENT

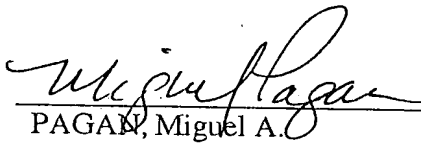
State of WISCONSIN )  
County of DANE ) ss:



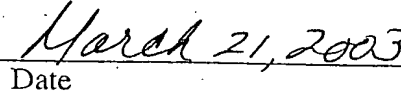
On the       day of       2003, DUNCAN, Scott M. personally appeared before me, known by me to be the same person described in and who executed the foregoing instrument, and acknowledged that he/she executed the same, of his/her own free will and for the purposes set forth.

[Signature]  
Notary Public  
~~~~~


ASSIGNOR authorizes and requests the Commissioner of Patents to issue any and all Letters Patent of the United States for said invention, resulting from any of the aforesaid applications to its ASSIGNEE.


PAGAN, Miguel A.

L.S.

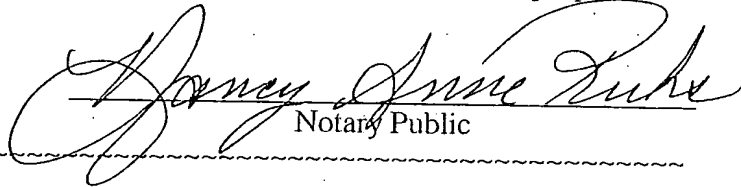

Date

ACKNOWLEDGMENT

State of New York)
County of Ulster)
SS:

NANCY ANNE RUHS
NOTARY PUBLIC, State of New York
Reg. No. 4972774
Qualified in Dutchess County
Commission Expires 10-4-04

On the 21 day of Mar 2003, PAGAN, Miguel A personally appeared before me, known by me to be the same person described in and who executed the foregoing instrument, and acknowledged that he/she executed the same, of his/her own free will and for the purposes set forth.


Notary Public

ASSIGNOR authorizes and requests the Commissioner of Patents to issue any and all Letters Patent of the United States for said invention, resulting from any of the aforesaid applications to its ASSIGNEE.

Middleton B. Floyd, Jr.
FLOYD, Middleton B. Jr.

L.S.

Date

3-18-03

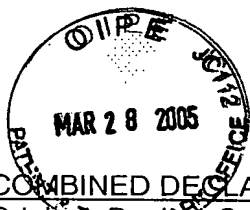
ACKNOWLEDGMENT

State of NEW YORK)
County of ROCKLAND) ss:

On the 18 day of March 2003, MIDDLETON, Floyd B. Jr. personally appeared before me, known by me to be the same person described in and who executed the foregoing instrument, and acknowledged that he/she executed the same, of his/her own free will and for the purposes set forth.

JANICE A. WHITE
NOTARY PUBLIC - STATE OF NEW YORK
NO. 01-WH6052604
QUALIFIED IN ROCKLAND COUNTY
MY COMMISSION EXPIRES 12-26-2006

Janice A. White
Notary Public



COMBINED DECLARATION AND POWER OF ATTORNEY
(Original, Design, Supplemental, Divisional, Continuation, CIP)

As the below named inventor, I hereby declare that:

INVENTORSHIP IDENTIFICATION

My residence, post office address and citizenship are as stated below next to my name. I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled:

TITLE OF INVENTION

PROCESS FOR THE SYNTHESIS OF 3-CYANO-6-ALKOXY-7-NITRO-4-QUINOLONES

SPECIFICATION IDENTIFICATION

the specification of which: (complete (a), (b), or (c))

- (a) ☒ is attached hereto.
(b) ☐ was filed on _____ as
 ☐ Application Number
 ☐ Express Mail No. _____, as Application Number not yet known
(c) ☐ was described and claimed in PCT International Application No. _____ filed
 on _____ and as amended under PCT Article 19 on _____ (if any).

ACKNOWLEDGEMENT OF REVIEW OF PAPERS AND DUTY OF CANDOR

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose information which is material to the patentability of this application in accordance with Title 37 CFR 1.56(a).

PRIORITY CLAIM

I hereby claim foreign priority benefits under Title 35, United States Code, Section 119 of any foreign application(s) for patent or inventor's certificate or of any PCT International application(s) designating at least one country other than the United States of America listed below and have also identified below any foreign application(s) for patent or inventor's certificate of any PCT International application(s) designating at least one country other than the United States of America filed by me on the same subject matter having a filing date before that of the application(s) on which priority is claimed.

- (d) ☐ No such applications have been filed.
(e) ☐ Such applications have been filed as follows.

NOTE: Where item (c) is entered above and the International Application which designated the U.S. claimed priority, check item (e), enter the details below and make the priority claim.

Earliest Foreign Application(s), if any, filed within 12 months (6 months for Design) prior to this U.S. Application

Country	Application No.	Date of Filing (Day, Month, Year)	Priority Claimed 35 USC 119

All Foreign Application(s), if any, Filed More Than 12 Months
(6 Months for Design) Prior to This U.S. Application)

CLAIM FOR BENEFIT OF PRIOR U.S. PROVISIONAL APPLICATION(S)
(35 U.S.C. § 119(E))

I hereby claim the benefit under Title 35, United States Code, § 119(e) of any United States provisional application(s) listed below:

PROVISIONAL APPLICATION NUMBER

FILING DATE

60/461,647

April 9, 2003

CLAIM FOR BENEFIT OF EARLIER U.S./PCT APPLICATION(S)
(UNDER 35 U.S.C. 120)

I hereby claim the benefit under Title 35, United States Code, Section 120 of any United States application(s) designating the United States of America that is/are listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in that/those prior application(s) in the manner provided by the first paragraph of Title 35, United States Code, Section 112, I acknowledge the duty to disclose material information as defined in Title 37, Code of Federal Regulations, Section 1.56(a) which occurred between the filing date of the prior application(s) and the national or PCT International filing date of this application.

**PRIOR U.S. APPLICATIONS OR PCT INTERNATIONAL APPLICATIONS
DESIGNATING THE U.S. FOR BENEFIT UNDER 35 USC 120**

U.S. Applications		Status (Check One)		
U.S. Applications	U.S. Filing Date	Patented	Pending	Abandoned
		<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
		<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
		<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
		<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>

PCT Applications Designating U.S.		
PCT APPLICATION NO.	PCT FILING DATE (Day, Month, Year)	U.S. APPLICATION NO. ASSIGNED (if any)

POWER OF ATTORNEY

As a named inventor, I hereby appoint the following attorney(s) and/or agent(s) to prosecute this application and transact all business in the Patent and Trademark Office connected therewith.

☒ Customer Number: 25291

☐ Attached as part of this declaration and power of attorney is the authorization of the above-named attorney(s) to accept and follow instructions from my representative(s).

SEND CORRESPONDENCE TO:

Customer Number: 25291

DIRECT ALL TELEPHONE CALLS TO:


Name: Joy S. Goudie
Tel. No. (845) 602-2126

DECLARATION

I hereby declare that all statements herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

SIGNATURE(S)

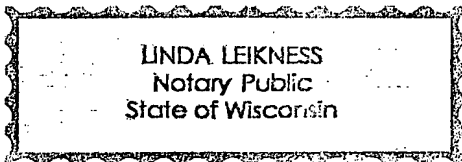
Full name of SOLE OR FIRST INVENTOR: **Seatt Mason DUNCAN**

Inventor's Signature  Date 3/9/04

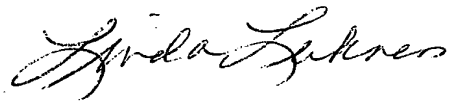
Country of Citizenship: **United States of America**

Residence : **10 Stonecrest Circle, Madison, WI 53717**

Post Office Address: **10 Stonecrest Circle, Madison, WI 53717**



My Commission Expires
July 11, 2004

 3/9/2004
State of Wisconsin
County of Dane

DECLARATION

I hereby declare that all statements herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Full name of SECOND JOINT INVENTOR: **Miguel Angel PAGAN**

Inventor's Signature _____ Date _____

Country of Citizenship: **United States of America**

Residence : **126 Robbins Road, Mount Hope, NY 10932**

Post Office Address: **126 Robbins Road, Mount Hope, NY 10932**

DECLARATION

I hereby declare that all statements herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Full name of THIRD JOINT INVENTOR: **Middleton Brawner FLOYD, Jr.**

Inventor's Signature Middleton Brawner Floyd, Jr. Date 03/05/04

Country of Citizenship: **United States of America**

Residence : **5 Babbling Brook Lane, Suffern, NY 10901**

Post Office Address: **5 Babbling Brook Lane, Suffern, NY 10901**

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